

REMARKS

Claims 1 and 49-72 are pending in this application. All pending claims have been finally rejected.

Applicants also note that the Examiner has not checked the box before “IDS (PTO-1449)” to indicate that the IDS filed on April 14, 2003 has been considered. In addition, Applicants have submitted a supplemental IDS with this response. Applicants respectfully request the Examiner to consider these two IDS’s.

Claim rejections under 35 USC §102

The Office Action states that claims 1, 49, 54-66, 70, and 71 stand rejected under 35 U.S.C. 102(e) as being anticipated by Eicher et al. (US 6,132,755).

Applicants submit that the rejection based on 35 U.S.C. 102(e) is improper. This application is a continuation of U.S. Application Serial No. 09/316,229, filed May 21, 1999, now U.S. Patent 6,334,856, which is a continuation-in-part of U.S. Application Serial No. 09/095,221, filed June 10, 1998, now U.S. Patent 6,503,231. The 102(e) date of the Eicher reference is June 16, 1998 (see the cover page of Eicher), which is later than the filing date of U.S. Application Serial No. 09/095,221. The Office Action acknowledged that the pre-AIPA 102(e) applies, since the PCT application on which Eicher relies was filed before Nov. 29, 2000. Thus, Eicher is not available as a 102(e) reference before June 16, 1998. Accordingly, Applicants respectfully request that the rejection of claims 1, 49, 50-66, 70, and 71 under 35 U.S.C. 102(e) as either being anticipated by or unpatentable over the Eicher reference be withdrawn.

However, Applicants also note that Eicher is a US national stage application filed under 35 U.S.C. 371. Its corresponding PCT application in German, and the German priority application upon which the PCT application rely to claim priority (both submitted herewith in a supplemental IDS), could be used as 102(b) references against the pending claims. Thus in anticipation of the new rejection the Examiner might raise, Applicants will address the merits of the Eicher reference (which is presumably the same as the PCT published in German).

Applicants have amended claim 1 to recite a requirement that the substrate and/or the microneedles are formed from flexible materials to allow the device to fit the contour of the biological barrier, thereby overcoming the Eicher reference. This amendment is explicitly supported by the instant specification (see the paragraph bridging columns 5 and 6 in the issued parent application USSN 09/316,229, which is now U.S. Patent 6,334,856). The same paragraph also explained the functional advantages of the feature now present in the claimed invention. This feature is neither explicitly or implicitly disclosed in the Eicher reference, thus Eicher cannot anticipate the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim rejections under 35 USC §103(a)

Claims 50-53 stand rejected under 35 U.S.C. 103(a) as being obvious over Eicher.

Claims 67 and 68 stand rejected under 35 U.S.C. 103(a) as being obvious over Eicher et al. in view of Gerstel et al. (US 3,964,482).

Claims 69 and 72 stand rejected under 35 U.S.C. 103(a) as being obvious over Eicher et al. in view of Godshall et al. (US 5,879,326).

As argued above, the amended invention recites features neither disclosed nor suggested by Eicher. Neither Gerstel nor Godshall teach or suggest the subject matter recited in the amended independent claims 1 and 70 from which claims 67-69 and 72 depend. Claims 67-69 and 72 should therefore be patentable for the same reasons that claims 1 and 70 are patentable. Thus Applicants respectfully request reconsideration and withdrawal of rejections on grounds of 35 U.S.C. 103(a).



Application No.: 10/010723

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CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

We believe that we have appropriately provided for fees due in connection with this submission. However, if there are any other fees due in connection with the filing of this Response, please charge the fees to our Deposit Account No. 18-1945, referencing the attorney docket number listed above.

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Respectfully submitted,

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